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**TECHNOLOGY CENTER 3800**

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In re Application of	:	
Maupin et al.	:	DECISION ON PETITION
Application No. 10/690,411	:	REGARDING REQUEST TO
Filed: October 21, 2003	:	WITHDRAW FINALITY
For: APPARATUS FOR APPLYING	:	UNDER 37 CFR 1.181
CHEMICALS TO RODENTS	:	

This is in response to applicants' petition under 37 CFR 1.181 filed October 26, 2005 requesting withdrawal of the finality of the Office action mailed July 5, 2005 as being premature.

The petition is **GRANTED**.

Applicants allege that the final rejection mailed July 5, 2005 is premature because the new grounds of rejection contained in the Office action was not necessitated by amendment.

A review of the record reveals that a first Office action was mailed November 18, 2004 in which the examiner rejected claims 1-5 and 10 under 35 U.S.C. 102(b) as being anticipated by Talley and claims 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Tally. Claims 1, 9 and 10 were also rejected under 35 U.S.C. 102(b) as being anticipated by Crawford. A response was filed April 18, 2005 in which claim 1 was amended to included the limitations of cancelled claims 2, 3 and 5. Claim 1 was also amended to remove the limitation "and having said chemical on said flexible web, whereby said web contacts rodents passing thereunder." Additionally, new claims 12-27 were added. A final Office action was mailed July 5, 2005 rejecting claims 1, 4 and 6-27 under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An after final amendment was filed on November 10, 2005 including a petition for a one month extension of time.

In the petition, applicants allege that the amendment filed April 18, 2005 narrowed the scope of the claims. Claim 5, as originally filed, is dependent upon claims 3, 2 and 1. In the amendment filed April 18, 2005, applicants narrowed the scope of claim 1 by incorporating the limitations of claims 2, 3 and 5. However, applicants also removed the recitation "and having said chemical on said flexible web, whereby said web contacts rodents passing thereunder" which was originally in claim 1. Thus, claim 1, as amended, is in essence claim 5, as originally filed, minus the deleted limitation. Therefore, applicants have broaden the scope of the claim.

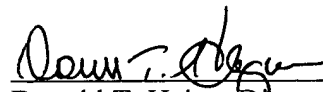
MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new grounds of rejection that is neither necessitated

by applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Since the amended claims are broader in scope than the claims, as originally filed, the examiner should have maintained the rejection from the first Office action. However, the examiner applied a new grounds of rejection. Although applicants amended claim 1, the amendments to the claims did not necessitate the new grounds of rejection.

The finality of the Office action mailed July 5, 2005, but not the action itself, is hereby vacated. The Office action of July 5, 2005 is now considered to be non-final and the shortened statutory period for response continues to run FOUR (4) MONTHS from the date of mailing of the Office action, i.e., four (3) months from July 5, 2005. Furthermore, the amendment after final rejection filed November 10, 2005 will be entered.

The application will be forwarded to the Head Supervisory Legal Instruments Examiner for removal of the "final" status from the July 5, 2005 action and for entry of the November 10, 2005 amendment and then to the examiner for consideration of the amendments. However, if the amendment raises a new ground of rejection, the next Office action will be made FINAL.

  
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DH/tl: 11/23/2005

